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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,781	01/15/2004	Ali R. Rezai	12637/95	6304
23838 7590 10/02/2008 KENYON & KENYON LLP 1500 K STREET N.W. SUITE 700 WASHINGTON, DC 20005				
EXAMINER				
OROPEZA, FRANCES P				
ART UNIT		PAPER NUMBER		
3766				
MAIL DATE		DELIVERY MODE		
10/02/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/758,781

Applicant(s)

REZAI, ALI R.

Examiner

FRANCES P. OROPEZA

Art Unit

3766

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/25/08 (RCE) and 5/27/08 (Amendment).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31, 32, 35 and 36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 31, 32, 35 and 36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Request for Continued Examination

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/25/08 has been entered.

Response

2. The Applicant's comments filed in the response of 5/27/08 have been fully considered and are convincing relative to the 35 USC § 102 rejections of the instant invention as being anticipated by Schiff (U.S. Patent No. 5,938,688) and as being anticipated by Stypulkowski (U.S. Patent No. 6,944,497). As a result, the 35 USC § 102 rejections of record related to Schiff and Stypulkowski are withdrawn and a new rejection established in the subsequent paragraphs.

Claim Rejections - 35 USC § 112

3. Claims 31, 32, 35 and 36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Examiner is unable to find in the instant specification the limitations of:

“delivering a first electrical stimulus to an intralaminar nuclei of a brain of a mammal in need of treatment of a psychiatric disorder or psychiatric function; and delivering a second electrical stimulus to another area of the brain, wherein the another area of the brain is not the intralaminar nuclei;”

these amendments made in the 1/19/07 and 5/27/08 responses by the Applicant. New matter may not be added at this point in the process. Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. Claims 31, 32 35 and 36 are rejected under 35 U.S.C. 102(e) as being anticipated by John (U.S. Patent No. 6,463,328).

John discloses a method of neural stimulation in sites in the brain substantially the same as the instant invention to treat psychiatric disorder or a psychiatric function such as depression, schizophrenia, anxiety disorders, drug addiction and alcoholism, the method comprising:

delivering a first electrical stimulus to the intralaminar nuclei of a brain, and

delivering a second electrical stimulus to another area of the brain, wherein the another area of the brain is not the intralaminar nuclei, but rather the anterior limb of the internal capsule (abstract; column 1, lines 12-24; column 6, lines 7-13; column 16, lines 45-48; column 22, lines 18-24; column 26, lines 1-10, 36-47; column 27, lines 29-46).

Relative to the internal capsule, the deep gray matter of the cerebrum is formed by centers of cell bodies called basal nuclei. The general term corpus striatum is used to describe the combination of these basal nuclei and the white matter that encapsulates the basal nuclei, the

white matter known as the internal capsule. Basal nuclei are divided into a medial group and a lateral group. The lateral basal nuclei have a lens shaped nuclei, the lentiform nucleus, located on the anterior limb of the basal nuclei. John teaches stimulation of the globus pallidus internus (column 22, lines 22-23) recognized as the smaller more medial part of the lentiform nucleus, hence John is read to teach stimulation of a second site in the brain, the anterior limb of the internal capsule, that is not the intralaminar nuclei.

As related to claims 35 and 36, John discloses a diagnostic phase, where activity in an area of the brain is sensed, this search read to not be limited to the intralaminar nuclei of a brain (column 6, lines 13-31).

Specification

5. The amendment filed 1/19/07 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

“delivering a first electrical stimulus to an intralaminar nuclei of a brain of a mammal in need of treatment of a psychiatric disorder or psychiatric function; and delivering a second electrical stimulus to another area of the brain, wherein the another area of the brain is not the intralaminar nuclei;.

The Applicant is required to cancel the new matter in the reply to this Office Action.

Statutory Basis

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fran Oropeza whose telephone number is (571) 272-4953. Fran's schedule typically is Monday and Tuesday 9AM-7PM EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl H. Layno can be reached on (571) 272-4949. Carl's schedule typically is Monday, Wednesday, Friday 9AM-5 PM EST; Tuesday, Thursday 9AM-3PM and 9PM-11PM EST. The fax phone numbers for the organization where this application or proceeding is assigned is (571) 273-8300 for regular communication and for After Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Frances P. Oropeza/
Patent Examiner, Art Unit 3766
September 25, 2008

/Carl H. Layno/
Supervisory Patent Examiner, Art Unit 3766

